

REMARKS

INTRODUCTION

In accordance with the foregoing, claims 1-7 have been amended, and claims 8-12 have been added. No new matter is being presented, and approval and entry are respectfully requested.

Claims 1-12 are pending and under consideration. Reconsideration is respectfully requested.

REJECTION UNDER 35 U.S.C. §102

In the Office Action at pages 2-4, numbered item 3, claims 1 – 4 and 6 were rejected under 35 U.S.C. §102(e) in view of U.S. Patent No. 6,711,160 B2 to Chan, et al. The reasons for the rejection are set forth in the Office Action and therefore not repeated. This rejection is traversed, and reconsideration is respectfully requested.

Amended independent claim 1 is directed to an apparatus for initiating and receiving voice and data calls and, in relevant part recites “gateway means for establishing a path between said first port and said second port inside said apparatus in response to a request from a server on the packet based telecommunication network acting on behalf of a caller.”

Amended independent claim 4 is directed to a system for telecommunication utilizing both a circuit switched telecommunication network and a packet based telecommunication network that includes multiple telecommunication apparatuses for initiating and receiving voice and data calls. In relevant part, amended independent claim 4 recites that the each of the multiple telecommunication apparatus includes “gateway means for establishing a path between said first port and said second port inside said telecommunication apparatus in response to a request from a server on the packet based telecommunication network acting on behalf of a caller.” Rejected claims 2, 3, and 6 depend, either directly or indirectly, from these independent claims.

Chan, et al. describes telecommunication apparatuses that include gateway means, but the usage of the gateway function is limited to a group of people who know the address of a suitable gateway apparatus and, therefore, can connect to it directly. When acting as a gateway from the packet based network to the PSTN network, the apparatus disclosed by Chan, et al. assumes that the signaling comes from the caller, extracts the destination PSTN number, and connects to the called party on the PSTN. Chan, et al. fails to teach or suggest that the

voice data can come from a source other than the signaling source. Rather, it assumes that signaling and voice go together, in the same way as on a telephone line.

An apparatus according to the present invention, as specified in amended independent claim 1, instead receives signaling from a *server* and handles a request to *connect a third party caller* to the called party on the PSTN. The server does not pass the voice data stream for the telephone call, and will not be connected to the PSTN.

The present invention, as specified in amended independent claim 4, is directed to the use of multiple telecommunication apparatuses with a built in gateway function to serve as a *distributed gateway system* as a replacement for the multi-line network gateways that are present in a conventional gateway system.

To realize the distributed gateway system, the invention includes *gateway location servers* on the packet based network. Each telecommunication apparatus will register with a gateway location server when it elects to be part of the distributed gateway system for third party callers. Each registered telecommunication apparatus also has means for automatically notifying the gateway location server when its PSTN connection is Off Hook, so it is temporarily unavailable to connect calls to the PSTN.

When any third party caller on the packet based network requests a connection to a telephone on the PSTN, its request is sent to a gateway location server, which selects a suitable registered apparatus to serve as a gateway, and then requests from the selected apparatus that the third party caller be connected to the called party at the PSTN. The gateway location server can also keep tab on charges incurred by the third party caller, and reimbursement due the selected apparatus. The gateway location server is not connected to the PSTN, so it is not a gateway, and it does not pass the voice data stream for the telephone call. It is only a facilitator in the telecommunication system according to the invention. These functions are described in detail in the Specification, at least at page 7, line 17 through page 10, line 11.

Chan, et al. describes a gateway functionality intended solely for users in a private location or within a workgroup. It does not teach or suggest that the gateway capability from the packet network to the PSTN can be used by *third parties* located anywhere on the packet network. For such usage additional means are required, such as gateway location servers. Chan, et al. does not teach or suggest the use of gateway servers to select one of its telecommunication apparatuses to act as a gateway for a calling third party.

Independent claims 1 and 4 have been amended to include language specifying the relationship between a telecommunication apparatus and a gateway location server on the packet based network according to the invention. Amended independent claims 1 and 4 clearly distinguish the claimed invention from the apparatus described by Chan et al. The present invention represents an important advance in the art. Accordingly, Applicant respectfully submits that amended independent claims 1 and 4 and claims 2, 3, and 6, which depend either directly or indirectly therefrom, are in condition for allowance. Further, as newly added dependent claims 11 and 12 depend from amended independent claims 1 and 4, respectively, Applicant respectfully submits that new claims 11 and 12 patentably distinguish over the prior art for at least the reasons set forth above and are, thus, also in condition for allowance.

REJECTION UNDER 35 U.S.C. §103

In the Office Action at pages 4-5, numbered item 5, claims 5 and 7 were rejected under 35 U.S.C. §103(a) in view of Chan, et al. and U.S. Patent No. 6,259,691 B1 to Naudus. The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

Applicant respectfully submits that Items 40 and 80 in the Naudus reference are not “telecommunication apparatuses for initiating and receiving voice and data calls” as specified in the claims of the present invention. Items 40 and 80 are conventional multi-line network gateways, or exactly what the present invention intends to replace. The only “apparatuses for initiating and receiving voice and date calls” disclosed by Naudus are Plain Old Telephones 10, 12, 13 connected to circuit switched networks.

The Naudus reference describes a conventional telephony system where a packet based network is utilized by a telephone company as a carrier for part of the distance between a caller and a call recipient on a PSTN. The servers 22, 24 and 25 direct traffic to the multi-line network gateways 40 or 80 based solely on the area code in the telephone number.

Naudus fails to teach or suggest the possibility of using servers on a packet based network for registering multiple *one-line* gateways distributed over a wide area and selecting one of these distributed gateways, many of which normally are within the same area code defined by the telephone number, for forwarding a call to the PSTN. Further, Naudus fails to teach or suggest that the gateway is an apparatus at an end user's location, using the regular telephone line for the connection to the PSTN.

Chan, et al. discloses a telecommunication apparatus with built in gateway means, but the disclosed telecommunication apparatus can not handle a request from a server to connect a third party call from a packet based network to a PSTN. Chan, et al. did not grasp the advantage of using such apparatuses as part of a distributed gateway system.

Applicant acknowledges that, in "hindsight", it may seem obvious to include gateway means in individual end-user telecommunication apparatuses. Hindsight, however, is not a valid objection to the patentability of a new combination of existing elements (see our previous Response, filed January 2, 2004, page 7, last paragraph). It is well-established that references must be viewed without the benefit of hindsight vision provided by the present invention (see, e.g., *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)). Further, the references, considered as a whole, must suggest the desirability of making the combination (see, e.g., *Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Co.*, 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984)). Additionally, the Examiner must consider the claimed invention as a whole because, although the difference between the claimed invention and the prior art might seem slight, it could also be of great importance to the advancement of the art (see, e.g., *Jones v. Hardy*, 727 F.2d 1524, 1529, 220 USPQ 1021, 1024 (Fed. Cir. 1984)).

In support of Applicant's position, Applicant respectfully submits that shifting the location of gateways from a few concentrated locations operated by telecommunication companies to a large number of local individual gateways represents several advantages over the state of the art in 1999. Shifting the gateways to individual users allows unlimited, immediate expansion and eliminates the bottlenecks experienced when the user base expands more rapidly than the telecommunication companies increase network capacity. Additionally, the reliability and stability of the telecommunications system are improved because the gateways are distributed. If one gateway is damaged, the effect on the total system will be negligible because the load on the gateways is more widely distributed. Finally, the Gateway Telephone 200 presents an economic benefit in that the inclusion of a gateway minimally impacts the cost of the device. In contrast, the network gateways used by telecommunications companies require a physical location, as well as more expensive hardware. Thus, by incorporating gateway means into individual end-user telecommunication apparatuses, the present invention creates both economic and practical advantages over the system presently utilized for IP telephony.

Applicant respectfully submit that there is nothing disclosed or implied in Chan, et al. or Naudus, individually or in combination, that would make the present invention obvious. Further, as claims 5 and 7 depend, either directly or indirectly, from amended independent claim 4, Applicant respectfully submits that dependent claims 5 and 7 patentably distinguish over the prior art for at least the same reasons as amended independent claim 4. Accordingly, Applicant respectfully submits that dependent claims 5 and 7 patentably distinguish over the prior art and are in condition for allowance. Reconsideration and approval is sincerely requested.

NEW CLAIMS

New claims 8-12 have been added to set forth the invention in varying scope. New claim 8 is original claim 5 rewritten in independent form by inclusion of all of original claim 4. New claims 9 and 10 are dependent on new claim 8. New claims 11 and 12 depend from amended independent claims 1 and 4, respectively. Approval of the new claims 8-12 is respectfully requested.

REQUEST FOR EXAMINER INTERVIEW

After examination of the above response, Applicant's Attorney respectfully requests an interview with the Examiner to discuss the patentability of the claims.

CONCLUSION

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. And further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited.

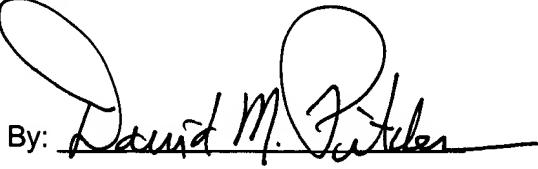
If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited by the Examiner contacting the undersigned attorney for a telephone interview to discuss resolution of such issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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